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Michael Weisser

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/506,477  
Filing Date: September 01, 2004  
Appellant(s): WEISSER, MICHAEL

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Milton Oliver  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/27/2008 appealing from the Office action mailed 1/14/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of Claim 5 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saito.

**NEW GROUND(S) OF REJECTION**

Claim 5 is rejected under 35 U.S.C. 103(a) as obvious over Saito in view of Yamamura et al. (RE. 33,652).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|           |                 |         |
|-----------|-----------------|---------|
| 5,979,541 | Saito           | 11-1999 |
| 5,650,678 | Yokozawa        | 7-1997  |
| 5,650,676 | Blumenberg      | 7-1997  |
| RE33,652  | Yamamura et al. | 7-1991  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito 5,979,541.

Saito discloses in figure 4 a fan, comprising: external-rotor motor, 7, having an internal stator 6 and an external rotor separated therefrom by an air gap as seen in Figure 4 between 62 and 74; a bearing support tube 35 mounted on a base 31, the internal stator 6 being mounted on the support tube 35; and a pot-shaped part 62 having one end connected to said base 31, forming a substantially fluid-tight annular space enclosing

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said internal stator 6, and having a wall (wall of 62) which extends in the manner of a canned motor through said air gap between the internal stator 10 and the external rotor; wherein an end of said bearing support tube 35 which is remote from said base 31 extends to a portion 62 of said pot-shaped part and forms a substantially fluid-tight connection therewith; wherein an end of said bearing support tube 35 which is remote from said base 31 extends to a portion 61 of said pot-shaped part 62 and forms a substantially fluid-tight connection therewith; wherein the base 31 forms a substantially fluid-tight connection with a fan housing 2 (Figure 4); wherein the pot-shaped part 62 is integrally formed with the housing 2 of the fan; wherein the base 31 connected to the bearing support tube 35 is integrally formed with the housing 2 of the fan.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saito.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product

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of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Claims 6-12, 16, 18 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Yokozawa et al. 5,650,678 and in further view of Blumenberg 5,650,676.

Saito teaches the claimed invention substantially except for explicit teaching for a spacer and retaining element. Yokozawa discloses a bearing holder for a motor wherein a bearing support tube 4 is formed with a recess shown in figure 1 next to 4 in which a spacer col. 2, ll. 52-60, a retaining element 16 for securing the shaft 14, and a plurality of ball bearings 12 are provided; wherein said recess shown in figure 1 next to 4 of the bearing support tube 4 is configured as a blind bore; wherein the recess shown in figure 1 next to 4 of the bearing support tube 4 is so configured, at its closed end; wherein the rotor is configured as an external rotor with a rotor bell 13 onto which a rotor shaft 14 is secured; between the rotor bell 13 and an inner ring of one of the ball bearings around 12, a spring 15 is provided, which is compressible during assembly, placed in the recess of the bearing support tube 4 into a circumferential groove formed on the rotor shaft 14; wherein the motor is an electronically commutated motor (brushless DC motor ) whose rotor 13 has a rotor magnet 18 and has a stator 8 with a stator lamination stack, see 8 figure 1, the stator being arranged, at least partially, radially inside the rotor magnet 18; wherein the rotor 13 is arranged substantially in magnetic equilibrium

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relative to stator lamination stack, in order to reduce or avoid any axially directed magnetic force between rotor 13 and stator 8; wherein the rotor 13 has a shaft 14 which is axially fixed by a securing ring 16 which engages into a circumferential groove of the shaft 14. It would have been obvious to one of ordinary skill in the art to modify Saito in view of Yokozawa to make the assembly steps easier and to reduce noise Col. 6, ll. 34-47. Saito in view of Yokozawa does not teach a retaining clip. Blumenberg provides teaching for a retaining clip 57 that is used to put two parts of the motor housing together as seen in Figure 1. It would have been obvious to one of ordinary skill in the art to modify Saito in view of Yokozawa further in view of Blumenberg to obtain a simple assembly that is accurate and pre-centered Col. 3 ll. 11-26.

It is Examiner's position that there is no difference between the prior art fan and a fan in which the base is fluid-tightly connected to the fan house by ultrasonic welding and there is also no difference between the prior art fan and a fan in which the pot-shaped part is connected to the base by adhesion or welding.

### **NEW GROUND(S) OF REJECTION**

Claim 5 is rejected under 35 U.S.C. 103(a) as obvious over Saito in view of Yamamura et al. (RE. 33,652)

With regard to claim 5 it should be noted that bead weld is a commonly used welding means in the art and such welding is superior in efficiency and low in cost. (Yamamura et al. RE33,652). It would have been obvious to one of ordinary skill in the art to modify

Saito in view of Yamamura to provide a low cost and efficient welding solution (Yamamura Col. 6 ll. 55-64)

#### **(10) Response to Argument**

Applicant's arguments have been fully considered but they are not persuasive. Saito discloses a **substantially fluid tight** annular space as noted by the appellant that fluid **may pass** to the inside. The prior art which allows some flow falls within the scope of 'substantially fluid tight' as it allows some fluid to pass through the annular space. It should be clear that substantially fluid tight does not mean fluid tight. It should be clear that Saito does not disclose a fluid tight space but it discloses a fan, comprising: external-rotor motor, 7, having an internal stator 6 and an external rotor separated therefrom by an air gap as seen in Figure 4 between 62 and 74; a bearing support tube 35 mounted on a base 31, the internal stator 6 being mounted on the support tube 35; and a pot-shaped part 62 having one end connected to said base 31, forming a substantially fluid-tight annular space enclosing said internal stator 6, and having a wall (wall of 62) which extends in the manner of a canned motor through said air gap between the internal stator 10 and the external rotor; wherein an end of said bearing support tube 35 which is remote from said base 31 extends to a portion 62 of said pot-shaped part and **forms a substantially fluid-tight connection therewith**; wherein an end of said bearing support tube 35 which is remote from said base 31 extends to a portion 61 of said pot-shaped part 62 and forms a substantially fluid-tight connection therewith; wherein the base 31 forms a substantially fluid-tight connection with a fan



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housing 2 (Figure 4); wherein the pot-shaped part 62 is integrally formed with the housing 2 of the fan; wherein the base 31 connected to the bearing support tube 35 is integrally formed with the housing 2 of the fan.

With regard to applicant's argument that combination of Saito, Yokozawa and others to reject the invention is erroneous, it is held that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in

the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

In response to Applicant's argument that appellant's arrangement is cost-effective and does it in an environmentally responsible manner, Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although the advantage that the invention is cost effective etc. are found in the specification, they are not limiting the claim structurally over the prior art. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be

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relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Vikansha Dwivedi

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**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/KAREN M. YOUNG/

Karen M. Young

Director, Technology Center 3700

Conferees:

Devon Kramer

/Devon C Kramer/

Supervisory Patent Examiner, Art Unit 3746

/Janet C. Baxter/

TC 3700 TQAS